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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/828,473	04/21/2004	Hiroya Fukuyama	12706/13	5144
23838 7590 05/16/2007 KENYON & KENYON LLP 1500 K STREET N.W. SUITE 700 WASHINGTON, DC 20005			EXAMINER FINEMAN, LEE A	
			ART UNIT 2872	PAPER NUMBER
			MAIL DATE 05/16/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/828,473

Applicant(s)

FUKUYAMA ET AL.

Examiner

Lee Fineman

Art Unit

2872

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 March 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 11, 12 and 16-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 11, 12 and 16-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Continued Examination Under 37 CFR 1.114*

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9 March 2007 has been entered in which claim 11 was amended. Claims 11-12 and 16-18 are pending.

### *Claim Rejections - 35 USC § 103*

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 11-12 and 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kudo et al., JP2001198141A in view of Shioda et al., US 6,081,371 (henceforth Shioda '371) and Nakanishi et al., JP 2001299695A.

Kudo et al. disclose a microscopic observing apparatus (fig. 1) comprising: a probe microscope (33); an auxiliary microscope (2); a specimen stage (operating table 61 and floor as base) on which is placed a subject (32) of observation that is to be observed using the probe microscope and the auxiliary microscope that allows an absolute position of the subject of observation to be adjusted (via 3, 4, 5, 6, 7 and 8 around axes O<sub>1</sub>, O<sub>2</sub>, O<sub>3</sub>, O<sub>4</sub>, and O<sub>5</sub>); a light

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irradiation device (not shown, see paragraph [0015] of machine translation) that irradiates light onto the subject (32) of observation, wherein the auxiliary microscope is located such that the light irradiated onto the subject of observation is visible (fig. 2); and a microscope holding member (3) that holds both of the probe microscope and the auxiliary microscope on the specimen stage (fig. 1), wherein the microscope holding member comprises a Z stage (5 and 62, see paragraph [0015] of machine translation) that stands upright on the specimen stage (fig. 1); a  $\theta$  stage (6) that is mounted on a top end of the Z stage (fig. 1); an arm (7) that extends horizontally towards and above of the specimen stage, and that holds both of the probe microscope and the auxiliary microscope (fig. 1); a rotating member (8) that is linked to a distal end of the arm so as to be rotatable around a horizontal axis; the probe microscope is attached to the arm so as to face an upper surface of the specimen stage (figs. 1 and 2), and the auxiliary microscope (2) is held such that an optical axis thereof intersects an optical axis of the probe microscope (fig. 2); and wherein the probe microscope (32) is held such that a distal end thereof appears at a substantially central position in a visual field of the auxiliary microscope (fig. 2).

Kudo et al. disclose the claimed invention except for the light source being a laser that is coaxial with the optical axis of the probe microscope and provides a marker on the subject of observation visible to the auxiliary microscope; and wherein the auxiliary microscope is a video microscope including a CCD camera with a macro lens.

Shioda '371 teach in fig. 1 a microscopic observing apparatus comprising: a probe microscope (3) and an auxiliary microscope (1) and wherein the auxiliary microscope is a video microscope including a CCD camera (12) with a macro lens (in so far as the images from the auxiliary microscope are of a lower magnification than those from the probe microscope - see

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figs. 3 and 4). It would have been obvious to one of ordinary skill in the art at the time the invention was made to add the CCD camera of Shioda '371 to the auxiliary microscope of Kudo et al. to be able to record the images from the auxiliary microscope for easier viewing with a monitor (Shioda '371, column 9, lines 39-43).

Nakanishi et al. teach a microscopic observing apparatus (figs. 6- 8) comprising: a probe microscope (34) and an auxiliary microscope (2) and a laser light irradiation device (54) that irradiates light that is coaxial with the optical axis of the probe microscope ( $O_2$ ) onto the subject of observation and provides a marker (59a, 59b) on the subject of observation visible to the auxiliary microscope (see figs. 7 and 8). It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the light source of Kudo et al. a laser light source that provides markers and is coaxial with the optical axis of the probe microscope as taught by Nakanishi et al., to easily determine positioning of the probe (see Nakanishi English Machine Translation, pages 6-9).

### *Response to Arguments*

4. Applicant's arguments with respect to claims 11-12 and 16-18 have been considered but are moot in view of the new ground(s) of rejection.


### *Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lee Fineman whose telephone number is (571) 272-2313. The examiner can normally be reached on Monday - Friday 7:30 - 5:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephone B. Allen can be reached on (571) 272-2434. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
LAF  
2 May 2007

  
MARK A. ROBINSON  
PRIMARY EXAMINER